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EXPEDITED PROCEDURE
RESPONSE AFTER FINAL
GROUP ART UNIT 3644

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
WAKAYAMA, Sean) Atty. Dkt. No.: R-8767
Serial No.: 08/917,480) Group Art Unit: 3644
Filed: August 26, 1997) Examiner: T. Dinh
For: RECONFIGURATION CONTROL SYSTEM) Dated: December 12, 2000
FOR AN AIRCRAFT WING)
)

REQUEST TO WITHDRAW PREMATURE FINALITY

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Assistant Commissioner for Patents
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Washington, D.C. 20231

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Sir:

In response to the Office Action dated October 13, 2000, Applicant requests reconsideration and withdrawal of the finally rejected status given the most recent Office Action in view of the following facts and circumstances:

(1) The Board of Appeals issued a Decision on Appeal dated July 27, 2000 reversing the rejection of record at that time and remanding the case for further prosecution before the Examiner. *Inter alia*, the Board of Appeals remanded the case to the examiner "... to consider the patentability of claims 1-20 under 35 U.S.C. § 103 over the cited prior art. In addition, the examiner should consider searching for other prior art [footnote content omitted]" (Decision on Appeal, p. 6).

(2) Thus, the Board of Appeals itself did not make a new grounds of rejection of the claims, but instructed the Examiner to make further patentability determinations and consider further searching of the prior art.

(3) After remand, in the Office Action dated October 13, 2000 the Examiner has made a new prior art rejection based under 35 U.S.C. § 103 based in part on a newly cited prior art reference (viz., US Pat. No. 4,146,200 to Borzachillo).

(4) The Office Action of October 13, 2000 was made **FINAL** by the Examiner, without an explanation being presented on the justification for this action (see cover page-Form PTO-326, and p. 3).

(5) Applicant did nothing in the record to necessitate this new grounds of rejection.

(6) As explained in the Manual of Patent Examining Procedure (M.P.E.P., Feb. 2000), the effect of a new rejection, if made, by the Board of Appeals is that the "...rejection under 37 C.F.R. 1.196(b) in effect nullifies the final rejection or indication of allowability and reopens prosecution of the subject matter of the claims so rejected by the Board. ... The appellant may amend the claims involved, or substitute new claims to avoid the art or reasons adduced by the Board" (MPEP § 1214.01).

(7) Consequently, the Examiner has assigned a "finally" rejected status in this application when the Board of Appeals would not have, had the Board instead imposed this new grounds of rejection under 37 CFR 1.196(b).

(8) Applicant respectfully submits that this clear-cut incongruity and disparity in treatment, depending on whether the Board itself or the Examiner made the completely new grounds of rejection based on the newly cited prior art, is arbitrary and/or an unreasonable exercise of discretion.

(9) In view of these facts and circumstances, Applicant submits that the "final" status assigned to the Office Action dated October 13, 2000 by the Examiner was unjustified and premature.

(10) The "final" status assigned to this application is prejudicial to Applicant because, among other things, he will be deprived of his right and option to freely amend the claims, based upon his original disclosure, as a manner of responding to the new grounds of rejection advanced in the Office Action of October 13, 2000. Moreover, Applicant now faces the costs of the extension period if this application is not somehow placed in condition for final disposition by no later than January 13, 2001.

(11) Accordingly, as a remedy, Applicant respectfully requests written notification that the "finality" assigned to the Office Action dated October 13, 2000 has been withdrawn (M.P.E.P. 706.07(d)).

(12) Applicant also requests prompt action on this request so that in the event of an unfavorable decision on this request within the examining group, Applicant will have sufficient time to petition for review under 37 C.F.R. § 1.181 (M.P.E.P. 1002.02(c)).

If the Examiner believes that a teleconference would be useful in expediting the prosecution of this application, the official is hereby invited to telephone the undersigned counsel to arrange for such a conference.

Respectfully submitted,

WESTERLUND & POWELL, P.C.

By Ramon R. Hoch
Ramon R. Hoch
Reg. No. 34,108

Westerlund & Powell, P.C.
122 N. Alfred Street
Alexandria, VA 22314-3011
(703) 706-5862 (tele); (703) 783-8458 (fax)